

REMARKS

Claims 1 and 3 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Young*, U.S. Patent No. 2,834,134.

Claim 1 requires, *inter alia*, a "front panel comprising a transparent portion that is not imaged." The transparent portion **18** is shown in the drawing figures, and is disclosed in the specification on page 3, at lines 13-14.

Young does not teach a front panel comprising a transparent portion that is not imaged. *Young* teaches a frame **14** "provided with the usual window or opening which is in communication with the interior of the body **10** to provide access to the interior of the box or body." Accordingly, *Young* teaches a window that permits access to the interior of the body by providing an opening, but does not teach a transparent portion that is formed of a transparent or substantially transparent material, as taught by the specification of the instant application. See generally, Specification, page 3, line 13 through page 4, line 6. Further, *Young* recites clip **30** as projecting into the window **16**, which it could not do if the window were not an opening or void in the frame. Column 2, lines 7-9.

Anticipation of a claim under 35 U.S.C. §102 can only be found if the prior art reference discloses every element of the claim. *In re Paulsen*, 30 F.3d 1475,

1478-79 (Fed.Cir.1994). Anticipation requires the presence, in a single prior art disclosure, of all elements of a claimed invention arranged as in the claim; a prior art disclosure that "almost" meets the claim is not anticipation. *Structural Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 707, 716 (Fed.Cir.1984). Anticipation requires proof by clear and convincing evidence. *Shearing v. Iolab Corp.*, 975 F.2d 1541, 1544 (Fed.Cir.1992). A 102(b) reference must contain a disclosure which would enable someone to practice the invention as claimed. *Reading & Bates Const. v. Baker Energy Res Energy Res.*, 748 F.2d 645 (Fed.Cir.1984)..

Since *Young* does not disclose a transparent portion as required by Claim 1, Claim 1 is not anticipated by *Young*. Further, the present invention, by using a transparent portion that is spaced apart from an image, with an intervening light source, creates a glow within the display box that highlights the image. Even a transparent material, such as glass, will have some reflectance that will directs light back into the box and to the image, thereby creating a glow. This feature is not created by the device shown in *Young*.

Claim 3 requires that the transparent portion of the front panel comprise not less than fifty (50%) percent of the front surface area of the front panel. The front panel of *Young* must be seen as comprising both the frame 14 and the silhouette 36 that is attached to the frame. The silhouette is generally vertically disposed, and is positioned opposite the light bulb from the rear panel.

Accordingly, the structure of *Young* that is analogous to the front panel of the present invention includes the frame 14 and the silhouette 36, and this front panel comprises more than fifty percent of the front surface area of the front of the *Young* device. Further, as with Claim 1, Claim 3 requires a transparent portion, and no such transparent portion is presented by *Young*. Accordingly, *Young* does not meet the limitations of Claim 3.

Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Young* in view of *Yu*, U.S. Patent No. 5,265,357. It is the Examiner's position that *Yu* shows a rear panel 30 that includes a photograph 10c. However, there is nothing in *Yu* or *Young* that suggests that a photograph should be positioned against the rear panel, so that the photograph is highlighted by an electric light that is disposed between a front panel having a transparent portion and a rear panel. It would not be obvious to one skilled in the art reading *Young* to highlight a photograph in this manner, nor would it be obvious to one skilled in the art from reading *Yu* to highlight a photograph by inserting it on the back panel of the *Young* device. Further, *Young* does not teach a front panel having a transparent portion that assists in highlighting the photograph.

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Young* in view of *Cannady*, U.S. Patent No. 6,668,477. Claim 4 requires a front panel and a rear panel that are substantially parallel to each other. *Cannady* is specifically directed to viewing 3-D visual images. There is nothing in

Cannady to suggest or motivate one skilled in the art to provide a generally parallel rear panel and generally front panel for the purpose of highlighting images attached to the rear panel. It should be kept in mind that the front panel of Claim 1 requires a transparent portion. In attempting to make a *prima facie* rejection under Section 103(a), the Official Action states that *Cannady* "would allow the front panel to be made in an easier, faster, and less expensive manner." However, the parallel front portion of the present invention, with its transparent portion, provides for proper viewing of the image. When the image is viewed through the transparent portion, it is not distorted if the front panel and rear panel are generally parallel, while at the same time, some light is reflected back into the box to enhance the glow of the image within the box. Neither *Young* nor *Yu* set forth any suggestion or motivation for combining the references to arrive at the invention set forth in Claim 4, nor does the Official Action set forth a *prima facie* obviousness rejection by stating such suggestion or motivation. Claim 4 is addressed to one possible embodiment of the invention.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Young* in view of *Brody*, U.S. Patent No. 3,783,544. Claim 5 requires that the front and rear panels are joined by four sides, where at least a portion of the interior of the four sides comprises a reflective material. *Brody* teaches a reflective material. However, *Brody* does not teach positioning the reflective material between a front panel and the image, as is required by Claim 5. There is no suggestion or motivation found in *Young* or *Brody* to position the reflective

material between a front panel having a transparent portion and the image. The combination of Young and Brody do not meet the limitations of Claim 5

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Young*. Rejections under 35 U.S.C. §103(a) must be found in the prior art, not in the applicant's specification. As the Official Action points out, "Young does not disclose whether the front panel and rear panel are spaced apart by at least 2.5 centimeters." The Official Action goes on to state that "it would have been obvious to one in the art to modify Young by spacing the rear panel and front panel apart by at least 2.5 centimeters since this would help to make the image appear to be three dimensional."

It is respectfully submitted that a *prima facie* obviousness rejection is not set forth with regard to Claim 6, since there is no teaching in the prior art with regard to spacing the front panel and the rear panel apart a minimum of 2.5 centimeters. Further, *Young* does not teach a front panel having a transparent portion.

Claims 7 through 20 are added by amendment. These claims are allowable, *inter alia*, for the reasons set forth with regard to Claims 1 through 6. Further, Claim 7 requires that the image is viewable through the transparent portion without obstruction. While *Young* does not teach a transparent portion of

Application No.: 10/616,640
Title: LIGHTED IMAGE DISPLAY

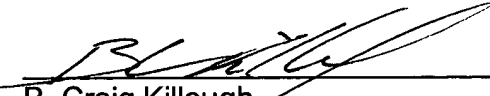
Examiner: Brian Green
Group Art Unit: 3611

the frame, the view of the image on the back panel is, in any event, intentionally obstructed by the silhouette.

A replacement sheet for Figure 2 is enclosed.

A replacement specification is also enclosed. The copy of the specification as filed did not have the spelling errors recited in the Official Action. In each case, as set forth in the Official Action, an "e" is missing from the affected word. The Applicant speculates that the Examiner was given a copy of the specification scanned at the USPTO, and that the scanner is defective.

Respectfully submitted,



B. Craig Killough
Attorney for Applicant
Registration Number 30,398
P.O. Drawer H
Charleston, SC 29402-0197
(843) 577-7700

Dated: October 6, 2004